

REMARKS

In the Final Office Action,¹ the Examiner:

rejected claims 1-42 and 44² under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Publication No. 2005/0137901 to Siegel (“Siegel”); and

rejected claim 43 under 35 U.S.C. § 103(a) as unpatentable over Siegel in view of U.S. Publication No. 2001/0032143 to Haseltine (“Haseltine”).

Claims 1-44 are pending.

Applicant respectfully traverses the rejection of claims 1-42 and 44 under 35 U.S.C. §102(b) as anticipated by Siegel.

In order to properly establish that Siegel anticipates Applicant’s claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in a single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Claim 1 recites “communicating the captured disposition decision from the computer based first management system to a computer based second management system.” Siegel does not disclose or even suggest at least this element of claim 1.

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

² The Office Action states on page 2 that only claims 1-42 are rejected under 35 U.S.C. § 102(b). Since, however, an explanation for the rejection of claim 44 is provided in the same section as the explanation for the rejection of claims 1-42, Applicant assumes that claim 44 is also rejected under 35 U.S.C. § 102(b).

The Final Office Action states that “[p]aragraph [0009] {of Siegel} discloses ‘{s}ubsequently, disposition of the returned product may be determined based on guidelines that generally eliminate unnecessary shipping and handling. As such, once the returned product is in the control of a local returns agent, it may be immediately and automatically processed for disposition.’ The communication of the disposition decision is construed as the product being returned after a determination is made by the guidelines. The result of the product being returned is evidence that there was communication of the disposition information involved” (curved brackets and emphasis added). Office Action p. 16. This interpretation of Siegel, however, is not correct.

The Office Action establishes that it interprets the claimed “communicating the captured disposition decision” as “the product being returned after a determination is made by the guidelines.” Office Action p. 16. While it is not clear from the Office Action, Applicant assumes that the Office Action is alleging in Siegel that when a “local returns agent” receives a product returned by a customer, it generates a “disposition” and that the “disposition,” generated by the “local returns agent,” is communicated by whether or not the product is returned by the “local returns agent” to some other returns agent. But, this interpretation is not consistent with the recitations of, for example, claim 1.

Even if it is assumed that whether or not in Siegel a product is returned constitutes “communication of the disposition decision,” which Applicant does not concede, the Office Action does not even allege that in Siegel the “disposition decision” is communicated “from the computer based first management system to a

computer based second management system," as claimed in claim 1 (emphasis added). Nothing in Siegel discloses or suggests that the "disposition decision" is "communicated" between "management system[s]."

In order to overcome this deficiency of Siegel, the Office Action alleges that "result of the product being returned is evidence that there was communication of the disposition information involved" (emphasis added). Office Action p. 16. But, this is improper reasoning for a rejection under 35 U.S.C. § 102(b) at least because "evidence" is not express or inherent disclosure. Under 35 U.S.C. § 102(b), the Office Action must show inherent or express disclosure of "each and every element" of the claims. See M.P.E.P. § 2131. The fact that the Office Action relies on "evidence" that "communication" is "involved," shows that the Office Action cannot show the "express disclosure" required to support a rejection under 35 U.S.C. § 102(b). Thus, the Office Action must be relying on principles of inherency as a legal basis for the rejection of, for example, claim 1.

The M.P.E.P., in section 2112 (IV), states

"[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic . . . To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient'" (emphasis original).

The rejection should be withdrawn at least because even if the "products" returned by the "local returns agent" to some other returns agent "communicat[e] a disposition decision," which Applicant does not concede, there is nothing that discloses or suggests as a matter of necessity that this "disposition decision" is communicated between a "computer based first management system and a computer based second

management system,” as claimed in claim 1. In other words, just because a “product” is returned, does not necessarily indicate that “disposition decision” for the product is communicated between “computer based” management systems. Therefore, the Office Action has not demonstrated explicit or inherent disclosure in Siegel of each and every element of, for example, claim 1.

Inasmuch as Siegel does not disclose or suggest each and every feature of, for example, claim 1, the rejection of claim 1 under 35 U.S.C. § 102(b) is improper at least because (1) there is no disclosure, either explicit or inherent, in Siegel that discloses or suggests that the “disposition decision” is communicated “from [a] computer-based first management system to a computer based second management system” and (2) “evidence that there was communication of the disposition information involved” (Office Action p. 16) is an insufficient legal basis for a rejection under 35 U.S.C. § 102(b) at least because “evidence” that “communication” is “involved” does not constitute express or inherent disclosure of each and every element of the claim.

Notwithstanding the above discussion, the rejection of, for example, claim 1 is improper for at least the following separate and distinct reason. Claim 1 recites “triggering, in response to the captured disposition decision, at least one process in the computer based second management system” (emphasis added). Siegel does not disclose or even suggest this element of claim 1.

The Office Action states “[p]aragraph [0009] discloses, ‘[s]ubsequently, disposition of the returned product may be determined based on guidelines that generally eliminate unnecessary shipping and handling. As such, once the returned product is in the control of a local returns agent, it may be immediately and

automatically processed for disposition. If the returned product is selected for liquidation, it may be automatically listed on an associated Internet auction website where it is preferably liquidated via online auction.' **The product being selected for liquidation and being listed on an associated internet auction is construed as 'at least one process'**" (curved brackets and bolded underlining added, underlining original). Office Action p. 17. But, this interpretation of the term is incorrect at least because it is inconsistent with the Office Action's stated interpretation of the claims.

As pointed out in Applicant's response of June 3, 2009, the Office Action construes the "second management system" as being equivalent to the "customer's account." See Reply to Office Action dated June 3, 2009. Thus, in order to be consistent with the Examiner's stated interpretation of on page 17 of the Office Action, the "selection" and "listing" of a product on an "internet auction" must also take place within a "customer's account," which it obviously does not. In alleging that the "selection" and "listing" constitute the claimed "at least one process," the Office Action has failed to consider that claim 1 recites that the "at least one process" is "in the computer based second management system." **The Office Action cannot construe the claimed "second management system" as a "customer's account" when rejecting one element of claim 1 (Office Action p. 3) and assert that the claimed "second management system" is a "selection" and "listing" in an internet auction when explaining the rejection of another element of claim 1 (Office Action p. 17).** Inasmuch as the Office Action has not clearly shown a "second management system," in Siegel, that satisfies each of the claim elements, the rejection of claim 1 is improper. Since the Office Action has not satisfied its burden to show each and every element of

the claim in issue disclosed in the Siegel reference, the rejection of claim 1 should be withdrawn.

For at least the above reasons, independent claim 1 is not anticipated by Siegel.

Claims 2-7 are allowable for at least the reason that they depend from allowable claim 1. Independent claims 8, 12, 18, 25, 29, 34, and 44, although of a different scope, include recitations similar to those discussed above in relation to independent claim 1 and are not anticipated by Siegel for reasons at least similar to those discussed above with respect to claim 1. Claims 9-11, 13-17, 19-24, 26-28, 30-33, and 35-42 are allowable for at least the reason that they depend from one of the allowable independent claims. Therefore, the Examiner should withdraw the rejection of claims 1-42 and 44 under 35 U.S.C. § 102(b).

Claim 43 depends from allowable independent claim 34 and therefore incorporates every element of claim 34. Since claim 34 is allowable, claim 43 is allowable for at least the same reasons as claim 34 inasmuch as Haseltine does not remedy the above discussed deficiencies of the independent claim. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 43, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

CONCLUSION

Applicant respectfully requests that the Examiner consider this response under 37 C.F.R. § 1.116, establishing that the pending claims are in condition for allowance.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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